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Bernard Bene

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

BASS, DIRK R

ART UNIT

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

Applicant argues that the functional limitations incorporated into claim 60 define patentable subject matter over the prior art and that it is improper for the examiner to reject such claims on the basis of intended use. In response, the examiner restates that claims 4-17, 20-36, 60-61 are drawn to and replete with functional and intended use language that does not structurally differentiate the controller. The controller of STERNBY is implicitly capable of manipulating the data from the sensor readings to determine the progress of the treatment (as shown above) and directing treatment based on sensor readings and data calculations (see claims 26-49 of STERNBY). The equations, data manipulations and data collection at different time intervals in the claims appear to be similar expressions as in the reference, but rearranged and using different notations. In any case, the mathematical expressions for calculating a parameter is not a patentable limitation in an apparatus as it does not *structurally* distinguish the claimed invention from the apparatus of STERNBY.

Additionally, it has been held that an apparatus must be distinguished from the prior art in terms of *structure rather than function*. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Since applicant fails to distinguish the structure of a controller over the prior art, the examiner maintains that such claims are anticipated or obviated by the prior art recited in the office action dated December 17, 2009.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIRK BASS whose telephone number is (571) 270-7370. The examiner can normally be reached on Mon - Fri (9am-4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/
Primary Examiner, Art Unit 1797

/DRB/
Dirk R. Bass